

III. REMARKS

Claims 1-11 were originally filed in United States Serial No. 10/669,187 on September 24, 2003. Applicant has amended independent claims 1 and 6 by the present amendment. Applicant has also added new dependent claim 12. Applicant respectfully requests reconsideration of this application and allowance of claims 1-12.

35 U.S.C. §112

Claims 1-5 have been rejected under 35 U.S.C. §112, second paragraph. It is specifically alleged that there is no antecedent basis for the phrase “said driven rollers” of claim 1, line 22. Applicant has amended the phrase “said driven rollers” to “said driven roller” in claim 1, line 22. Support for this amendment is found in the Specification at Page 10, lines 8-9, and FIGS 4 and 5. Applicant respectfully submits that the rejection of claims 1-5 is now moot.

The phrase “said driven rollers” is also found in claim 6 (page 16, line 2). Applicant has also amended the phrase “said driven rollers” in claim 6 to “said driven roller.” Support for this amendment is found in the Specification at Page 10, lines 8-9, and FIGS 4 and 5.

35 U.S.C. §102

Claims 1 and 2 have been rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,542,349. Application respectfully traverses this rejection.

The present invention is directed to a device for returning paper at, near, or around a paper input area of a paper folding machine, and a paper folding machine including the paper return device.

In contrast to the present invention, United States Patent No. 5,542,349 is directed to a pressing device. It does not disclose or suggest a device for returning paper at, near, or around a paper input area of a paper folding machine. For anticipation to apply, each and every claim limitation must be disclosed by United States Patent No. 5,542,349. United States Patent No. 5,542,349 does not teach that the pressing apparatus returns paper at, near, or around a paper input end of a paper folding machine. This reference also does not disclose or suggest a paper folding device incorporating the folded paper return device.

The Office Action alleges that the pressing device is inherently a “feeding/returning station” and is located downstream from a folding station. Applicant respectfully disagrees with this allegation. First, there is simply no teaching or disclosure that the pressing device is located downstream from a folding station.

Secondly, United States Patent No. 5,542,349 expressly teaches that the pressing device includes a conveying direction (F) in which folded paper (33) travels. Even assuming that there is a hypothetical paper folding station upstream from the “pressing station,” the folded paper only travels in conveying direction (F). Thus, the folded paper cannot be returned “at, near, or around a paper input end” of the upstream paper folding machine. Accordingly, the hypothetical proposed in the Office Action, that the pressing device is a “feeding/returning station” and paper is returned at, near, or around the paper input end of an upstream paper folding device, is simply untenable. Thus, it is not inherent that the pressing device is also a paper returning device. Because United States Patent No. 5,542,349 does not disclose each and every limitation of claims 1 and 2, these claims are not anticipated by this reference. Applicant, therefore, respectfully requests that this rejection be withdrawn.

35 U.S.C. §103

Claims 3-11 have been rejected under 35 U.S.C. §103(a) over United States Patent No. 5,542,349. Applicant respectfully traverses this rejection.

With respect to claims 3-5, United States Patent No. 5,542,349 does not disclose, suggest, or provide motivation for a device for returning folded paper at, near, or around a paper input end of a paper folding machine. United States Patent No. 5,542,349 is not a paper folding machine, nor is it a device for returning folded paper. Additionally, United States Patent No. 5,542,349 does not disclose, suggest, or provide motivation that the driven rollers of the pressing device are adopted to be mounted to the frame of a paper folding machine. Thus, it does not matter whether the pressing device of United States Patent No. 5,542,349 is modified to include three conveyor belts, as the pressing device does not return paper at, near, or around the input area of a paper folding device. Applicant, therefore, respectfully submits that claims 3-5 are non-obvious in view of United States Patent No. 5,542,349.

Applicant also traverses the rejection of claims 6-11. Claims 6-11 are directed to a paper folding machine including a frame, a sheet feeder support by the frame, a paper folding mechanism, and a device for returning folded paper at, near, or around the paper input end of the paper folding device.

It is first alleged that United States Patent No. 5,542,349 discloses a sheet feeder for delivering paper to a sheet folding mechanism, because it is inherent that the pressing station is also considered a “returning station” located downstream of a folding station.

As stated above, United States Patent No. 5,542,349 discloses a pressing device for folded paper. There is simply no teaching, suggestion, or motivation that the pressing device is a device for returning folded paper to the input end of a paper folding apparatus, or that the pressing station is used in conjunction with a paper folding device.

There is no disclosure, suggestion, or teaching in this reference of a folding station upstream from the pressing device. Therefore, there is no disclosure, teaching or motivation to deliver unfolded paper to a paper folding device upstream from the pressing device. Assuming *arguendo*, that United States Patent No. 5,542,349 inherently teaches a paper folding device upstream of the pressing device, there is no disclosure, suggestion, or motivation that the pressing device returns folded and pressed paper back to the input end of an upstream-loaded paper folding device. This is true, as United States Patent No. 5,542,349

strictly teaches that paper enters the pressing device 33 and travels only in direction (F). There is no disclosure, suggestion, or motivation that the pressed paper is returned to an upstream input end. In fact, any modification of the pressing device that provides a conveying direction other than direction (F) would be against the express teachings of United States Patent No. 5,542,349. Thus, United States Patent No. 5,542,349 clearly teaches away from a paper return device for returning folded paper to an input end of a paper folding machine.

The Office Action expressly concedes that United States Patent No. 5,542,349 does not disclose that the device for returning folded paper is disposed underneath the sheet feeder and folding mechanism of the paper folding device. Application agrees. Nevertheless, it is alleged that it would have been obvious to modify United States Patent No. 5,542,349 to locate the device for returning folded paper underneath the sheet feed and folding mechanism. Applicant respectfully submits that this position is the result of improper hindsight reconstruction. There is no disclosure, teaching, or suggestion in United States Patent No. 5,542,349 for a paper folding device including the folded paper return device. Even if there was disclosure or suggestion of this type of device, there is no disclosure, suggestion, or motivation to locate the device for returning folded paper below the sheet feeder and folding mechanisms of the paper folding device. Thus, Applicant respectfully submits that claims 6-11 are allowable over United States Patent No. 5,542,329.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests reconsideration of the application, withdrawal of the rejections under 35 U.S.C. §§102, 103, and 112, and requests the issuance of a formal Notice of Allowance directed to claims 1-12. Should the Examiner have any questions regarding the present amendments and remarks, Applicant's undersigned attorney would welcome a telephone call.

Respectfully submitted,



Salvatore A. Sidoti, Esq. (Reg. No. 43,921)

Curatolo Sidoti, Co., L.P.A.

24500 Center Ridge Road, Suite 280

Cleveland, OH 44145

Telephone: (440) 808-0011

Facsimile: (440) 808-0657

Attorney for Applicant

10-22-04

Date